

REMARKS**Paragraphs 1 and 2 of the Office Action**

Claims 1,2, and 4 are rejected under 35 USC §102(b) as being anticipated by U.S. Patent 5,579,610 to Jackson.

10 As to the Jackson patent (610), applicant respectfully disagrees with the Examiner's characterization of Jackson's elements. First, the Examiner states that Jackson includes a plurality of elongate members each having an attached end and a free end, wherein the spikes are attached to one of the free ends. This is not what Jackson teaches. Jackson shows a pair of chains 22 that are attached along their length to a panel.
15 The chains each have two ends that are each attached to one of a pair of telescoping rods 18 and therefore the chains do not have a free end but each attached to the framing of the Jackson device. Additionally, the stakes are attached to the rods, not to the chains as stated by the Examiner. Jackson explicitly states at column 4, line 15 that the stakes are attached to rings which are then attached to the rods. The chain 22 is not attached the
20 rings 26, and even were they attached in such a manner, there would still not be shown elongate members having an attached end and a free end. The Examiner next states that the edge is of the same material as the net which is elastic. However, Jackson does not say this. Instead Jackson states that the net is "fabricated from a *flexible* material, such as a polyester synthetic resin...." Column 3, lines 35-36, emphasis added. Flexible is not
25 synonymous with stretchable as claimed by the applicant. The stretchable nature of the peripheral edge keeps applicant's panel tighter on the rose covering by pulling on the panel and the elongate members. The elongate members, which are not shown in Jackson, provide the user of applicant's device with the ability to selectively determine the placement of the stakes to ensure that they do not interfere with flowers adjacent to
30 the rose.

Claim 2 has been cancelled and its limitations incorporated into claim 1 to further distinguish the claims with respect to Jackson. For the reasons stated above, it is believed that the elements of claim 1 are not found in Jackson and therefore claim 1 and dependent claim 4 are in condition for allowance.

35 The applicant respectfully requests withdrawal of the rejection.

Paragraphs 3 and 4 of the Office Action

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,579,610 in view of U.S. Patent 5,456,043 to Dacon.

10 The Examiner here equates resilient with elastic. However, resilient is not defined within Dacon as being elastic and thus must be defined in view of its synonym which is “flexible.” The applicant has intentionally used the term “elastomeric” whose definition is to have the elastic properties of natural rubber. For this reason, Dacon does not show an elastic material and claim 3 is believed to be in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

15

Paragraph 5 of the Office Action

Claims 5-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,579,610 to in view of U.S. Patent 6,663,328 to Schmidt.

20 Applicant will not address Schmidt as applicant concedes that Schmidt teaches resiliently elastic elongated members. However, based on the discussion above, it is believed that claim 1 is in condition for allowance, and therefore claims 5-10, which ultimately depend from claim 1, are also believed to be in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

25

Paragraph 6 of the Office Action

Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,579,610 in view of U.S. Patent 6,663,328 and U.S. Patent 5,456,043.

30 It is believed that claims 11 and 12 are allowable for the reasons stated above that the elements of the device, and in particular the elastomeric loop having a plurality of elongated members attached thereto, are not shown within the prior art. Alternatively, even if the elements of the prior did form the current device, it is believed that the Examiner has improperly utilized hindsight reconstruction in order to find the elements of applicant’s device. This is supported on two grounds. The first is the high number of references required to form what is a very simple invention. Applicant’s device generally
35 includes only three elements; a panel, a plurality of elongated members, and spikes.

5 However, the Examiner has relied upon three citations in order to find those elements. That the Examiner required a different citation for each element is evidence that the Examiner has used applicant's claims as a recipe. The Examiner has selected these elements even though there is no motivation found within the devices. Applicant's device has a construction adapted for retaining a rose covering on a rose bush through a
10 winter season and in such a manner that the covering stays tight against a ground surface to prevent frost to the rose bush. Jackson discusses a net positionable over leaves so they do not blow away before they are collected. Dacon's device encapsulates a tree so that fruit falling from the tree is caught within a net. Schmidt discloses a device that is used for tying down a load. These are not analogous to a device holding down a rose covering
15 and thus their combination could only be made through hindsight. When a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

[T]he Examiner relied upon hindsight to arrive at the determination of
20 obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

25 In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

The second ground of support is the lack of elastic elongated members except by reference to Schmidt. Both Jackson and Dacon do not include elastic elongated members
30 even though such elastic members have been widely available for many decades. Jackson did not use elastic but instead attached the stakes to the net with rings because Jackson was using the weight of the rods to hold the leaves down. Dacon does not require elastic elongated members as that device is positioned on a tree and using elastic members would increase the risk of breaking tree branches. Because of the divergent
35 uses, there is no motivation taught in the prior art cited.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if

5 there is some suggestion or incentive to do so.' [citation omitted] Although
couched in terms of combined teachings found in the prior art, the same inquiry
must be carried out in the context of a purported obvious "modification" of the
prior art. The mere fact that the prior art may be modified in the manner
10 suggested by the Examiner does not make the modification obvious unless the
prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting
from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221
USPQ 929, 933 (Fed. Cir. 1984)). In the present case, there can be no desirability, as the
combinations would detrimentally affect the usefulness of the cited devices.

15 Claim 12 has been amended to better clarify that the rose covering is separate
from the device used to secure the rose covering to the grounds. Such a covering is not
found in the prior art and therefore the prior art is therefore necessarily deficient in that
use. For the above reasons, it is believed that claims 11 and 12 are in condition for
allowance.

20 The applicant respectfully requests withdrawal of the rejection.

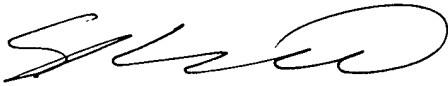
5

CONCLUSION

10 In light of the foregoing amendments and remarks, early consideration and
allowance of this application are most courteously solicited.

Respectfully submitted,

15



Sean A. Kaufhold (Reg. No. 46,820)
P.O. Box 131447
Carlsbad, CA 92013

Date: 6/18/04

20

(760) 470-3368 FAX (760) 631-1557